



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/660,465 | 09/10/2003 | Robert Wenz | 019433-000310US | 4940 |

20350 7590 06/16/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

SORKIN, DAVID L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1723

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,465

Applicant(s)

WENZ ET AL.

Examiner

David L. Sorkin

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 17-19 is/are rejected.
- 7) ☒ Claim(s) 20-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20 October 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8 and 17-25, drawn to a mixing syringe, classified in class 366, subclass 256.
 - II. Claims 9-16, drawn to a method of mixing, classified in class 366, subclass 348.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the mixing rod could force the liquid out of the plunger against or irrespective of gravity, rather than the liquid being released by gravity as required by claims 9-16.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Art Unit: 1723

5. During a telephone conversation with James Heslin on 06 June 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-8 and 17-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

7. Claims 20-25 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim shall not depend from a multiple depended claim. See also 35 U.S.C. 112, fifth paragraph and MPEP § 608.01(n). Accordingly, the claims 20-25 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 3, 7 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1723

a. In claim 3, there is lack of antecedent basis for "the mixing disk". It is unclear if the mixing element is required to be a disk.

b. In claim 7, there is lack of antecedent basis for "the scaling cylinder". Is this the same as or different from the "sealing cylinder" recited in claim 6.

c. In claim 17, the terms "preferably" and "like a piston" make unclear what is actually required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Guiney (US 4,116,240). Regarding claim 1, Guiney ('240) discloses a mixing syringe comprising a syringe barrel (110) having a hollow interior (146) and an outlet nozzle (14) at a lower end; a plunger (114) having a hollow interior (including 138) reciprocatably disposed in the hollow interior of the syringe barrel; a mixing rod (118) reciprocatably disposed in the hollow interior of the syringe barrel and having a mixing element (130) at its lower end which is adapted to mix material in the hollow interior of the syringe barrel upon reciprocation of the mixing rod; said plunger having a first relative position wherein the hollow interiors of the syringe barrel and of the plunger are sealed from each other (see Fig. 7) and a second relative position wherein the hollow interiors are in fluid communication (see Fig. 8). Regarding claim 2, the syringe further

Art Unit: 1723

comprises a frangible seal over the nozzle and a mandrel coupled to the mixing rod (see Figs. 6 and 7). Regarding claim 4, the mixing rod (118) is coaxially disposed through a passage in a bottom well of the plunger (see Figs. 6 and 7). Regarding claim 5, the mixing rod seal against the passage in the first relative position but not the second (see Figs. 6 and 7). Regarding claim 6, a sealing cylinder is disposed in the hollow interior of the plunger (see Figs. 6 and 7). Regarding claim 7, the mixing rod is disposed through coaxially aligned passages on the plunger and the scaling cylinder (see Figs. 6 and 7). Regarding claim 8, the syringe further comprises sliding seals on the mixing rod which are positioned to seal against the passages on the plunger and sealing cylinder when in the first position by not the second (see Figs. 6 and 7).

Allowable Subject Matter

12. Claim 3 would be allowable if rewritten to overcome the corresponding rejection under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. Claims 17-19 would be allowable if rewritten or amended to overcome the corresponding rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion


14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 1723

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David L. Sorkin
Primary Examiner
Art Unit 1723

DLS